

Remarks

A. Status of Application

Claims 1-12 were pending. New claims 13-32 have been added. No new matter has been added. Newly added claims 13-32 are supported by the specification. Claims 1-12 have been canceled. Claims 13-32 will be pending upon entry of this paper.

Claims 1-12 were rejected under 35 U.S.C. § 101. Claims 8, 10 and 12 were rejected under 35 U.S.C. §112, second paragraph. Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by Sendi et al., "Cost Effectiveness of Highly Active Antiretroviral Therapy in HIV-Infective Patients" (hereinafter "Sendi"). Claims 3, 6 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sendi in view of U.S. Patent Application No. 2003/0149596 to Bost (hereinafter "Bost").

B. Claim Objections

Claims 6 and 10 have been objected to as containing informalities. These objections have been overcome by newly added claims 13-32.

C. Claim Rejections 35 U.S.C. §112

Claims 8, 10 and 12 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite. These rejections are moot in view of the cancellation of claims 8, 10, and 12. Newly added claims 13-32 are not indefinite.

D. Claim Rejections 35 U.S.C. §101

Claims 1-12 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicants appreciate Examiners recommendations for resolving this issue. As suggested by the Examiner, new claims 13-32 include "A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform operations." Applicants assert, per Examiners observation, that this resolves the rejections under 35 U.S.C. § 101.

In addition, no new rejection under 35 U.S.C. § 101 should be issued. The Board of Patent Appeals and Interferences recently addressed the issue of whether a computer readable medium is statutory subject matter under § 101 in its post-*Bilski* opinion in *Ex parte Mazzara*. Appeal No. 2008-4741, BPAI (Feb. 5, 2009). In *Mazzara* the Board held that computer software recorded on a storage media “fall within the meaning of a ‘manufacture’ as defined in *Diamond v. Chakrabarty*.” Appeal No. 2008-4741, pg. 20 (citing 447 U.S. 303, 308 (1980), which states “[T]his Court has read the term ‘manufacture’ in § 101 in accordance with its dictionary definition to mean ‘the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations whether by hand-labor or by machinery.’”); see also *Warmerdam*, 33 F.3d at 1358, 1360 (holding that a claim directed to “[a] machine having a memory which contains data representing [well known mathematical constructs]” is directed to patentable subject matter under 35 U.S.C. § 101: a machine.). The Board went on to state:

The ultimate question though is not whether this type of claim reads on statutory “manufactures.” Rather, the more significant question is whether a claim that recites “a computer usable medium” should be interpreted so broadly as reading not only on statutory subject matter, but additionally reading on non-statutory subject matter as well. The Federal Circuit has not considered this precise issue, but the USPTO has, for a number of years, considered such claims to be statutory as a product claim. See *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994); see also MPEP 2106.01(I).

Id. Therefore, new claims 13-32 are patentable under 35 U.S.C. § 101.

E. Claim Rejections 35 U.S.C. §102

Claims 1-2 and 4-5 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by “Cost Effectiveness of Highly Active Antiretroviral Therapy in HIV-Infective Patients” by *Sendi et al.* (“Sendi”). Applicants assert that these rejections are moot in view of the cancellation of claims 1-12, but respectfully traverse with respect to any new rejections of claims 13-32.

Representative claim 14 reads:

14. (New) A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform operations for modeling savings associated with health care services, the operations comprising:

determining a savings based upon efficacy data from published research;

determining a savings based upon measured results, the measured results comprising one or more of the following savings components: gap closure savings, non-coverage determinations, cost avoidance, and productivity/revenue;

determining a savings based upon economic modeling methodologies, the economic modeling methodologies comprising savings assumptions; and

determining a savings based upon published data, the published data comprising one or more of the following components: clinical trials or observational data concerning complications or adverse events, published cost and savings estimates, and published wage data.

Claim 14 (emphasis added).

Applicants disagree with characterizations of the present claims and of the reference as found in the Office Action mailed September 5, 2008. Specifically, Applicants assert that Sendi fails to disclose every limitation of Claim 1.

“Anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” *Apple Computer, Inc. v. Articulate Systems, Inc.* 234 F.3d 14, 20, 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). An anticipation under section 102 is proper only if the reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). In determining whether a prior art reference anticipates a claim, it is necessary to (1) determine the scope of Applicant's broadest claim, (2) determine exactly what the single prior art reference discloses, and (3) compare each and every claim limitation against the prior art disclosure. *SSIH Equipment, S.A. v. U.S Int'l Trade Commission*, 218 U.S.P.Q. 678, 688 (Fed. Cir. 1983).

Claim 14 includes “**determining a savings based upon economic modeling methodologies,** the economic modeling methodologies comprising savings assumptions.” The Office Action points to Table 4 of Sendi in support of the rejection of this element of claim 14. Table 4 of Sendi describes “cost effectiveness of highly active antiretroviral therapy compared with no antiretroviral therapy in different scenarios of natural disease history.” The table then shows health care costs, years of life gained, and cost per year. However, Table 4 does not show savings, or describe “**determining a savings based upon economic modeling methodologies,** the economic modeling

methodologies comprising savings assumptions,” as recited in claim 14. Therefore, Sendi fails to anticipate claim 14.

Applicants respectfully assert that independent claim 1, is also patentable over Sendi for at least the same reasons as independent claim 14. Applicants further assert that dependent claims 15-25 are also allowable because of their dependence on allowable independent claim 14. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

F. Claim Rejections 35 U.S.C. §103

Claims 3, 6 and 7 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sendi in view of Bost. Additionally, claims 8-12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bost in view of “A Computerized Reminder system to Increase the Use of Preventative Care for Hospitalized Patients” by Dexter et al. (“Dexter”). Applicants assert that these rejections are moot in view of the cancellation of claims 1-12, but respectfully traverse with respect to any new rejections of claims 13-32.

Claim 26 reads:

26. A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform operations for modeling savings associated with health care services, the operations comprising:

determining a savings arising from a closure of a gap in health care;

determining a savings arising from a prospective review for non-covered health services;

determining a savings arising from health-related reminder programs; and

determining a savings arising from decreased absenteeism.

(Claim 26)(emphasis added).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071(Fed. Cir. 1988); M.P.E.P. § 2143.03.

In support of the rejection of independent claim 8, the office action states that Bost teaches “**determining a savings** arising from a **prospective review for non-covered health services**” at paragraphs [0161] and [0164] and Figure 8. (Office Action, September 5, 2008, pg. 10). Applicants respectfully disagree with this characterization of canceled claim 8 and of the prior art. In particular, Applicants assert that the cited references fail to teach or suggest all the limitations of canceled claim 8. Furthermore, Applicants assert that Bost fails to teach this element of independent claim 26.

Paragraph [0161] of Bost states:

[0161] As depicted in FIG. 3, the first task in calculating relative changes in absenteeism and low productivity days caused by differences in health plans in step 300 is to calculate the reduction in absentee days and low productivity days when a health condition is well controlled, step 310. As described above in the descriptions of the each of the medical conditions, the reduction in absentee days and low productivity days from the control of each of the health conditions may be studied and determined empirically. The difference in absentee days and low productivity days is determined in absolute terms, comparing little or no control of a condition versus of a high level of control of the condition.

Paragraph [0164] of Bost states:

[0164] The present invention may use statistical comparisons of two health care plans or classes of health care plans to determine the difference in the treatment/control rates of the various medical conditions. For instance, FIG. 8 illustrates a health care spreadsheet 800 containing HEDIS coefficients representing exemplary diabetes treatment levels in accredited plan compared to nonaccredited plans. The HEDIS rates reflect percentage of population covered for specific control measure, allowing straightforward comparisons of the different levels of health cares. In this way, the present invention allows the businesses to view the different treatment levels in two plans or classes of plans. As described above in the descriptions of the medical conditions, the HEDIS scores help determining the difference in care provided by the health plans. Also, as described above, the HEDIS scores may be used to create a multiplier representing the relative differences in the ability of a health plan to control a medical condition.

Neither of these paragraphs, nor Figure 8 teach “determining savings,” or in particular “**determining a savings** arising from a **prospective review for non-covered health services**,” as recited in claim 26. Therefore, the combination of Bost and Dexter fail to teach every element of independent claim 26. Consequently, independent claim 26 is patentable over Bost and Dexter.

In support of the rejection of independent claim 8, the office action states that Bost teaches “**determining a savings** arising from **decreased absenteeism**.” at paragraph [0161]. (Office Action, September 5, 2008, pg. 10). Applicants respectfully disagree with this characterization of canceled claim 8 and of the prior art. In particular, Applicants assert that the cited references fail to teach or suggest all the limitations of canceled claim 8. Furthermore, Applicants assert that Bost fails to teach this element of independent claim 26.

Again, as mentioned above, paragraph [0161] of Bost does not even mention “determining a savings.” Specifically, Bost fails to teach “**determining a savings** arising from **decreased absenteeism**,” as recited in claim 26. Therefore, the combination of Bost and Dexter fail to teach every element of independent claim 26. Consequently, independent claim 26 is patentable over Bost and Dexter.

The Examiner admits that Bost fails to teach “**determining a savings arising from health-related reminder programs**.” (Office Action, September 5, 2008, pg. 10). Nonetheless, in support of the rejection of independent claim 8, the office action states that Dexter teaches “**determining a savings arising from health-related reminder programs**” at pg. 965, left column 5th paragraph. (Office Action, September 5, 2008, pg. 10). Applicants respectfully disagree with this characterization of canceled claim 8 and of the prior art. In particular, Applicants assert that the cited references fail to teach or suggest all the limitations of canceled claim 8. Furthermore, Applicants assert that Dexter fails to teach this element of independent claim 26.

The cited paragraph of Dexter describes preventative care measures, such as vaccines generally. Additionally, the cited paragraph states that preventative care measures could result in “cost savings among patients who are at least 65 years old.” However, Dexter fails to teach “**determining a savings arising from health-related reminder programs**,” as recited in claim 26. Therefore, the combination of Bost and Dexter fail to teach every element of independent claim 26. Consequently, independent claim 26 is patentable over Bost and Dexter.

Therefore, Applicants respectfully assert that independent claim 26 is patentable over the combination of Bost and Dexter because the combination fails to teach or suggest all of the limitations of claim 26. Furthermore, Applicants respectfully assert that dependent claims 27-32 are also allowable because of their dependence on allowable independent claim 26. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants believe that these remarks fully respond to all outstanding matters for this application. Should the Examiner determine that further response is required, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney is respectfully requested in advance.

Conclusion

In light of the presented remarks, Applicants assert that claims 13-32 are patentable and in condition for prompt allowance. Should additional information be required, the Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone interview, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,



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